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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 555255-012551

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on July 22, 2008

Signature Debra Pejeau

Typed or printed name Debra Pejeau

Application Number	Filed
10/783,901	2004-02-20

First Named Inventor: Jason T. Griffin

Art Unit	Examiner
2173	Pillai, Namitha

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 47,919.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

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7/22/8
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255-012551

Group Art Unit:	2109	)
Examiner:	Pillai, Namitha	)
Inventor:	Griffin, Jason T.	)
Serial No.:	10/783,901	) **Pre-Appeal Request For Review**
Filed:	February 20, 2004	)
For:	Predictive Text Input System for a Mobile Communication Device	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This pre-appeal request for review responds to the Office Action mailed on April 24, 2008. Any fees due for filing this paper should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012551.

This is the second pre-appeal request for review filed in this case. The first pre-appeal request for review, which was filed in response to a Final Office Action mailed on September 14, 2007, identified three deficiencies in the Final Office Action. In response, prosecution was reopened. However, the Office Action mailed on April 24, 2008 has only addressed one of the three errors presented for review in the first pre-appeal request for review. Specifically, the new Office Action combines the previously cited Williams reference (EP 1296216A1) with the Suess reference (U.S. 7,216,588) in an attempt to show a predictive text system and device for use with a mobile device having a reduced-key QWERTY keyboard. However, the combination of Williams and Suess still fails to disclose or suggest at least two elements of independent claims 1 and 18: (1) an ambiguous word list comprising a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced-key QWERTY keyboard, wherein the keystroke combinations present in the ambiguous word list are associated with more than one common predicted word; and (2) a predictive text system module that

determines a predicted word and engages an alert mechanism on the mobile device if the input keystroke combination is present in the ambiguous word list. For at least these reasons, the Applicant submits that the Office Action fails to establish a *prima facie* rejection and must be withdrawn.

I. Williams Fails to Disclose a "an ambiguous word list. . ."

The office action refers to page 5, table 1, and also refers to page 2, paragraph [0003] of Williams, and in particular lines 20-24 thereof in support of its disclosure of "*an ambiguous word list comprising a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced key QWERTY keyboard, wherein the keystroke combinations present in the ambiguous word list are associated with more than one common predicted word*," as set forth in claim 1, for example. However, it is plainly evident that Table 1 of Williams, set forth below, does not disclose the claimed "ambiguous word list" as described in claims 1 and 18.

1 65	2 - abc	3 - def
4 - ghi	5 - jkl	6 - mno
7 - pqrs	8 - tuv	9 - wxyz
* - + 66	0 - ␣ 67	# - ⇧

Table 1. Layout of the alphanumeric keys 7.

Moreover, paragraph [0003] of Williams, set forth in its entirety below, doesn't come close to describing this claim limitation either:

> **[0003]** An object of the invention is to provide a mobile phone with a predictive editing program allowing more flexible text editing. This object is achieved by providing a mobile phone having a display, a keypad having a plurality of keys associated with several letters each and a further plurality of keys, processor means controlling the display means in accordance with the operation of the keypad, a predictive editor program for generating an output containing word matching a received string of ambiguous key strokes, an editor application controlled by the processor means for editing a text based on the predictive editor programs interpretation of key strokes, and comprising means for storing strings of entered words, means for storing a sequence of key stokes, said sequence being updated upon the occurrence of a new key stroke, and being used as input to the predictive editor program, means for storing a list of matching words received from said predictive editor program, said processor means combines the text string and one word from the list of matching words for displaying in the display of at least a part of said text string and one word from the list of matching words, said one word from the list of matching words is marked in comparison to the remaining part of the text string and added to the text string upon acknowledgement by the user, and said processor means displaying a cursor marking the position at which a character can be added or deleted.

Paragraph [0003] of Williams, and in particular lines 20-24 thereof, simply do not relate to the concept of an ambiguous word list as set forth in claims 1 and 18. Rather, this portion of Williams merely states that a predictive editor program generates an output containing a word matching a received string of ambiguous key strokes and also describes an "editor application controlled by the processor means for editing a text based on the predictive editor programs interpretation of key strokes, and comprising means for storing strings of entered words, means for storing a sequence of key strokes, said sequence being updated upon the occurrence of a new key stroke. . ." Notably missing from this portion of Williams is any mention of a list of ambiguous words, where the list comprises "*a plurality of keystroke combinations, each keystroke combination representing a plurality of key selections on the reduced key QWERTY keyboard*," as required by claims 1 and 18 of this application.

In a further attempt to justify this clearly erroneous rejection, the Office Action attempts to respond to the Applicant's arguments by making the following conclusions regarding the Williams reference (without including any specific citations):

> Applicant argues that Williams does not disclose an ambiguous word list. In contrast to Applicant's arguments, Williams discloses a list of matching words that represent the ambiguous word list. The list of matching words is generated in response to a sequence of keystrokes. This input of keystrokes is provided to the predictive editor program which generates a list of matching words that are associated with the sequence of keystrokes. Therefore the list represents a list of predicted words that are associated with the keystrokes. (Office Action, page 8).

The Applicant submits that the Examiner's characterization of the Williams reference (as set forth above) has absolutely nothing to do with an "ambiguous word list," as claimed. The instant application very clearly defines what is meant by an "ambiguous word list." For instance, at paragraph 0025 of the published application it is explained that "the ambiguous word list sets forth a plurality of keystroke combinations that are each associated with more than one possible predicted word." The cited references do not disclose anything similar to this. However, the Office Action attempts to equate the claimed "ambiguous word list" with a dictionary of words used by a standard predictive editor program. The Applicant submits that this interpretation completely ignores both the plain meaning of the claim terms and the clear meaning provided within the specification. For these reasons, the rejections cannot stand.

II. Williams Fails to Disclose an Alert, Engaged if a Keystroke Combination is Present in the Ambiguous Word List

In addition, the office action refers to page 3, paragraph [0022] of Williams (and in particular lines 56-58 thereof), in support of its disclosure of an alert mechanism that is engaged on the mobile device if the input keystroke combination is present in the ambiguous word list. This portion of Williams, however, which is set forth below in its entirety, only refers to highlighting letters of a word to-be-predicted as the user is typing on the telephone keypad so as to indicate to the user that the predictive editor system has not yet figured out what word is being typed, i.e., the word "has not been fixed yet."

> **[0022]** Data is entered on the keypad 2 which comprises of individual alphanumerical keys 7. Most of these keys 7 have multiple meanings, represented by letter, numbers and symbols printed on the keys. The entered text is shown in the display 3 of the phone. The text already entered (and accepted by the user) is shown in the same text format as the standard display format of the phone. The word presently being entered is underlined or reversed in colours in order to indicate that the letter string has not been fixed yet. The predictive editor is able to interpret individual keys and multiple key sequences in several ways simultaneously.

As described in more detail in the present application, the point of engaging the alert mechanism in the claimed invention is to point out to a user of the mobile device having a reduced-key QWERTY keyboard that the word which has been predicted may not in fact be the word that the user meant to type. Because certain keystroke combinations may not be easily discernable by the system, the alert mechanism, when combined with the appearance of the keystroke combination on the ambiguous word list, alerts the user that they may want to pay close attention to the predicted word so as to ensure the proper meaning of the entered text.

Recognizing this difference, the office action attempts to explain the rejection with the following conclusions regarding the Williams reference:

> Williams discloses an alert means through which one word is marked which alerts the user to the word. This alerted word represents the keystroke combination that is matched and presented in the ambiguous word list. (Office Action, page 8).

Once again, the conclusion of the Office Action relies on an unreasonably broad interpretation of the claimed "ambiguous word list." As explained above, the standard word list disclosed in Williams is not an "ambiguous word list." Therefore, activating an alert when a word is identified in Williams' word list is clearly not the same thing as engaging an alert mechanism when a keystroke combination is found in an

"ambiguous word list." An "ambiguous word list," as explained in the patent's specification includes a list of keystrokes that are associated with more than one word. That is, there is no way for a predictive text program to definitively identify which word is intended by the keystrokes included in the ambiguous word list. Thus, the word list is "ambiguous" because the listed keystrokes each have more than one possible corresponding word. In contrast, Williams simply discloses a list of words that are matched to keystrokes as they are typed. There is nothing "ambiguous" about the entries in Williams' list, and thus it cannot reasonably be interpreted as an "ambiguous word list" according to the plain meaning of the term. Further, the claim term "ambiguous word list" is very specifically defined by the specification, and thus the Examiner's interpretation is also unduly broad in light of the specification. Consequently, the rejections of independent claims 1 and 18 are clearly erroneous and must be withdrawn.

Respectfully submitted,

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